

JUL 31 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Mohamed A. MARAHIEL et al.

Group Art Unit: 1651

Application No.: 10/566,432

Examiner: Fernandez, S. E.

Filed: 09/19/2006

Attorney Docket No: 12180-0002

For: METHOD FOR THE PRODUCTION OF CYCLIC MOLECULES

ELECTIONCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of April 3, 2009, a petition for a three month extension of time is made and payment is addressed at the end of this filing.

Applicants elect the Group I Invention, claims 1-9, 15, and 16.

Applicants also elect species according to the groups identified in the office action as follows:

- a) S;
- b) R1, R2, R3, R4, and R5, each selected from -H, -OL, and -alkyl;
- c) Group L, alkyl; and
- d) claim 5.

The species election requirement for e) and f) is moot given the election of claims 1-9, 15, and 16. However, in the event that the traverse below causes the Examiner to reconsider the restriction requirement, Applicants provisionally elect DDD for species (e) and HOBt for species (f).

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Claims 1-4, 15, and 16 are generic according to the Examiner so that these claims are to be examined. Claim 5 reads on the elected species.

Applicants also traverse the allegation that there is no common technical concept between claims 1 and 10. In the restriction requirement, the Examiner has taken the position that a single common technical feature is missing between the Group I and Group II inventions so that the restriction requirement can be be. To support this, the Examiner alleges that the Group II invention has the step of adding a reagent activating the C-terminus of the peptide acid, a coupling additive and a charge-stabilized leaving group to the free peptide acid in a solvent, which is not found in claim 1.

The restriction requirement is improper since the Examiner has mischaracterized the single common technical feature found in claims 1 and 10. Each of these claims includes a charge stabilizing leaving group and it is this group that is the single common technical feature of the invention. The charge stabilizing leaving group is a component of claim 10 when making the substrate and the same charge stabilizing leaving group is found in claim 1 in making the cyclic peptide. Since the methods of claim 1 and claim 10 each employ the charge stabilizing leaving group, these claims ~~do~~ contain a single common technical feature of the invention and restriction between the method claims is improper.

In the reasoning for the restriction, the Examiner asserts that the charge stabilized leaving groups vary widely in structure. While there are variations admittedly, claims 1 and 10 each generically define the charge stabilized leaving group so that the scope of this technical concept is the same for claims 1 and 10. The Examiner's

comments relating to a change in the results of the reactions also cannot support the restriction requirement. The question is whether a single general inventive concept exists in claims 1 and 10, not whether other details of the two claims may not coincide. Applicants do not dispute that the method of claim 1 and the method of claim 10 are not the same. However, the differences between these two methods alone do not mandate a restriction when each shares a single general inventive concept, i.e., the charge stabilizing leaving group. Accordingly, the restriction requirement should be withdrawn and all claimed examined in accordance with the species election made above.

Applicants also traverse the grouping of species for restriction. The Examiner's requirement that Applicants elect a single species amongst the many listed is inconsistent with the practice suggested by MPEP 806.04(b), which instructs the Examiner to group species together that are unpatentable over each other. As an example, by requiring Applicants to select one species from (b), the Examiner is implying a distinction between -F, -Br, -I, and such a requirement is clearly inconsistent with the aforementioned MPEP section. At the very least, the species election requirement should be remade with a proper grouping amongst the species listed under (a) to (f).

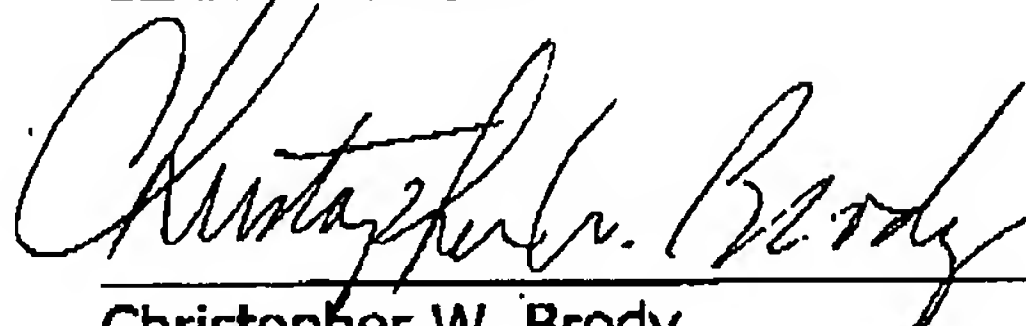
To summarize, Applicants submit that the restriction requirement and species election requirement are not proper. The restriction requirement should be withdrawn for the reasons given above and the species election requirement should be at least remade to more clearly group the species requiring separation.

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Applicants petition for a three month extension of time. Please charge the extension of time fee (\$555.00) and any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY



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